Appln. No.: 10/725,940   MTS-3582US
Amendment Dated December 23, 2008
Reply to Office Action of September 29, 2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No: 10/725,940
Applicant: Chiyoko Matsumi
Filed: December 3, 2003
Title: RECORDING AND REPRODUCING SYSTEM, RECORDING APPARATUS,
                    REPRODUCING APPARATUS, RECORD MEDIUM, RECORDING AND
                    REPRODUCING METHOD, RECORDING METHOD, REPRODUCING
                    METHOD, PROGRAM AND RECORD MEDIUM
T.C./A.U.:   2173
Examiner: Haoshian Shih
Confirmation No.:   4467
Docket No.:   MTS-3582US

AMENDMENT UNDER 37 C.F.R. § 1.116

Expedited Procedure

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

        Responsive to the Final Office Action dated September 29, 2008, please amend the
above-identified application as follows:

☐   **Amendments to the Specification** begin on page   of this paper.

☒   **Amendments to the Claims** are reflected in the listing of claims which begins on page
        2 of this paper.

☐   **Amendments to the Drawings** begin on page   of this paper and include an
        attached replacement sheet(s).

☐   **Amendments to the Abstract** are on page   of this paper. A clean version of the
        Abstract is on page   of this paper.

☒   **Remarks/Arguments** begin on page **7** of this paper.

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Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the application.

Listing of Claims:

1.   (Previously Presented) A recording and reproducing system comprising:

a record medium holding (1) a plurality of data files of storing predetermined data, (2) a plurality of play list files of storing a play list describing a reproduction order of the plurality of data files, and (3) a play list file menu file of storing a play list file menu which is information about a hierarchical structure by which the play list files are accessible;

play list file menu storing means of storing the play list file menu in the play list file menu file;

play list file menu display means of displaying to the outside play list file menu information on all or a part of the stored play list file menu;

play list file selecting means of selecting a predetermined play list file according to an instruction from the outside; and

data reproducing means of reproducing the predetermined data stored by the plurality of data files respectively by using the reproduction order based on the selected play list file.

2.   (Previously Presented) The recording and reproducing system according to claim 1, wherein the play list file menu display means is configured to display the play list file menu information in consideration of a type of the predetermined data reproducible by the data reproducing means.

3.   (Previously Presented) The recording and reproducing system according to claim 1, wherein the play list file menu display means is configured to display the play list file menu information by displaying at least one thumbnail image corresponding to at least one respective play list file, the displayed at least one thumbnail image changing according to a state in which the play list file selecting means selects the predetermined play list file.

4.   (Previously Presented) The recording and reproducing system according to claim 1, wherein the play list file menu display means is configured to display the play list file menu information by using predetermined text data on all or a part of the play list.

5.   (Previously Presented) A recording apparatus comprising:

play list file menu storing means of storing, in a play list file menu file, a play list file menu which is information about a hierarchical structure by which a plurality of play list files of storing a play list describing a reproduction order of a plurality of data files of storing predetermined data are accessible, wherein:

a record medium holds (1) the plurality of data files, (2) the plurality of play list files, and (3) the play list file menu file.

6.   (Currently Amended)   The recording apparatus according to claim 5, ~~wherein~~ ÷wherein:

the play list file menu information on all or a part of the stored play list file menu is displayed to the outside,

a predetermined play list file is selected according to an instruction from the outside, and

the predetermined data stored by the plurality of data files respectively is reproduced by using the reproduction order based on the selected play list file.

7.   (Previously Presented) A reproducing apparatus comprising:

play list file menu display means of displaying to the outside play list file menu information on all or a part of a play list file menu which is information about a hierarchical structure by which a plurality of play list files of storing a play list describing a reproduction order of a plurality of data files of storing predetermined data are accessible;

play list file selecting means of selecting a predetermined play list file according to an instruction from the outside; and

data reproducing means of reproducing the predetermined data stored by the plurality of data files respectively by using the reproduction order based on the selected play list file, wherein:

a record medium holds (1) the plurality of data files, (2) the plurality of play list files, and (3) a play list file menu file of storing the play list file menu.

8.   (Previously Presented) A record medium holding (1) a plurality of data files of storing predetermined data, (2) a plurality of play list files of storing a play list describing a reproduction order of the plurality of data files, and (3) a play list file menu file of storing a play list file menu which is information about a hierarchical structure by which the play list files are accessible.

9.   (Previously Presented) The record medium according to claim 8, wherein:

the play list file menu information on all or a part of the stored play list file menu is displayed to the outside,

a predetermined play list file is selected according to an instruction from the outside, and

the predetermined data stored by the plurality of data files respectively is reproduced by using the reproduction order based on the selected play list file.

10.   (Previously Presented) A recording and reproducing method comprising:

a play list file menu storing step of storing, in a play list file menu file, a play list file menu which is information about a hierarchical structure by which a plurality of play list files of storing a play list describing a reproduction order of a plurality of data files of storing predetermined data are accessible;

a play list file menu display step of displaying to the outside play list file menu information on all or a part of the stored play list file menu;

a play list file selecting step of selecting a predetermined play list file according to an instruction from the outside; and

a data reproducing step of reproducing the predetermined data stored by the plurality of data files respectively by using the reproduction order based on the selected play list file, wherein:

a record medium holds (1) the plurality of data files, (2) the plurality of play list files, and (3) the play list file menu file.

11.   (Previously Presented)   A recording method comprising a play list file menu storing step of storing, in a play list file menu file, a play list file menu which is information about a hierarchical structure by which a plurality of play list files of storing a play list describing a reproduction order of a plurality of data files of storing predetermined data are accessible, wherein:

a record medium holds (1) the plurality of data files, (2) the plurality of play list files, and (3) the play list file menu file.

12.   (Previously Presented) A reproducing method comprising:

a play list file menu display step of displaying to the outside play list file menu information on all or a part of a play list file menu which is information about a hierarchical structure by which a plurality of play list files of storing a play list describing a reproduction order of a plurality of data files of storing predetermined data are accessible;

a play list file selecting step of selecting a predetermined play list file according to an instruction from the outside; and

a data reproducing step of reproducing the predetermined data stored by the plurality of data files respectively by using the reproduction order based on the selected play list file, wherein:

a record medium holds (1) the plurality of data files, (2) the plurality of play list files, and (3) a play list file menu file of storing the play list file menu.

13.   (Previously Presented)   A tangible computer readable medium including a program that is adapted to control a computer to implement the method of claim 10.

14.   (Previously Presented)   A tangible computer readable medium including a program that is adapted to control a computer to implement the method of claim 11.

15.   (Previously Presented)   A tangible computer readable medium including a program that is adapted to control a computer to implement the method of claim 12.

16.-18. (Cancelled).

Remarks/Arguments:

Claims 1-15 are pending in the above-identified application. By the present Amendment, claim 6 is amended to remove an extraneous space. Claims 16-18 were previously cancelled.

Claim Rejections under 35 U.S.C. §102(b)

Claims 1-2 and 4-18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,614,732 to Nonaka et al. ("Nonaka"). It is respectfully asserted that Nonaka does not disclose all of the features of the claims.

In particular, Nonaka does not disclose the following features of claim 1:

> a record medium holding . . . (2) a plurality of play list files of **storing a play list describing a reproduction order of the plurality of data files . . .**

> . . .

> data reproducing means of **reproducing the predetermined data stored by the plurality of data files respectively by using the reproduction order based on the selected play list file.** (Emphasis added.)

These features are described in the specification of the above-identified application, for example, at page 14, lines 10-16; page 15, lines 7-20; page 27, line 13 - page 28, line 17; and in FIG. 2. No new matter has been added.

    1.   Overview of Nonaka

Nonaka discloses a recording and playback apparatus. As shown in FIG. 1, for example, the apparatus relevantly includes a disc 100, a hard disc 20, and a display portion 24. Using the apparatus, songs recorded on the disc 100 may be copied and stored onto the hard disc 20 and associated tag files may be generated and stored on the hard disc 20. A tag file identifies attributes, e.g., performer and genre, of an associated song. (See Nonaka, col. 9, lines 13-21.)

Within the hard disc 20, the stored songs are referenced to a music list according to the attributes of the songs. For example, songs may be referenced to lists which include songs associated with specific performers, music genres, etc. (See Nonaka, col. 9, lines 52-56.) The ordering of the songs in the lists is the result of the order in which the songs are read from the disc 100 and recorded to the hard disc 20. (See Nonaka, col. 9, lines 41-45 and lines 65-57.) Thus, the lists of Nonaka categorize songs by their attributes in the order in which they are recorded.

The titles of the lists may be displayed on the display portion 24. (See Nonaka, col. 10, lines 48-53 and FIG. 12.) The user selects the title of a list which includes the song he desires to hear **and then selects the song he wishes to hear from the displayed list.** (See Nonaka, col. 10, lines 59-62.) "Accordingly, the desired **songs can be selected** relatively easily even if enormous number of music data are recorded on the hard disc 20 . . . ." (See Nonaka, col. 10, lines 63-65.) (Emphasis added.) Thus, the lists of Nonaka provide a user with the ability to locate a song for playback.

2.   *The Office Action Misconstrues the Features Relating to Nonaka's "Play-Lists"*

The Office Action cites to col. 9, lines 36-45 of Nonaka as disclosing the features of claim 1 relating to the "plurality of play list files" and the "reproduction order." Specifically, the Office Action argues: "In response to applicant's argument, Nonaka discloses a play list stores a list of songs in the order of reproduction, upon the selection of the play list, the data files in the play list are visually reproduced on a display screen in accordance with the order of reproduction (col. 9, lines 40-45; col. 10, lines 48-51)."   (See Office Action, page 8.) (Emphasis omitted.)

Applicants understand that this portion of Nonaka cited in the Office Action includes the terms "play-list" and "reproduction." (See Nonaka, col. 9, lines 42 and 45.) Thus, because

Nonaka includes these terms, the Office Action appears to be arguing that Nonaka discloses "a record medium holding . . . (2) a plurality of play list files of storing a play list describing a reproduction order of the plurality of data files," as recited in claim 1. Applicants respectfully assert that this interpretation of Nonaka and Applicants' claim 1 is incorrect.

In FIG. 9, Nonaka illustrates and describes steps by which a "play-list," managed in a hard disc 20, is updated. Generally, FIG. 9 illustrates a flowchart of steps of a recording process for recording music data from a disc 100 (CD) onto the hard disc 20. (See Nonaka, col. 8, lines 34-46.) As music from the CD is **reproduced from** the CD and **recorded onto** the hard disc 20, the "play-list" corresponding to the category of the music being recorded is updated. (See Nonaka, col. 4, line 65 - col. 5, line 9; col. 9, lines 36-45 and lines 65-67.) Nonaka describes these features as follows:

> In FIG. 9, a play-list managed in the hard disc 20 is updated in accordance with the processings at the step S19 and the step S20 (step S21). In this embodiment, the music files of the recorded songs are classified into groups, the respective music files are listed and registered for each group, and the list is managed as the play-list. Accordingly, when a music file is newly recorded, the play-list is updated by distinguishing the group to which the song belongs, and arranging the file names of the respective music files **in order of reproduction.**
>
> (See Nonaka, col. 9, lines 35-45.) (Emphasis added.)

FIG. 11 of Nonaka illustrates the "play-list." This list indicates the order by which the songs are **recorded** onto the hard disc 20, category by category. (See Nonaka, col. 9, lines 36-45 and lines 65-67.) Specifically, Nonaka describes that "**when a music file is newly recorded,** the play-list is updated . . ." and "the play-list is automatically prepared **when the music data are recorded.**" (See Nonaka, col. 9, lines 42-43 and lines 66-67.) (Emphasis added.)

In contrast to Nonaka, in the embodiment of Applicants' invention recited in claim 1, "play list files" describe "a reproduction order of the plurality of data files" (e.g., songs). When

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a user wishes to listen to a particular play list, the user may select that play list. **The songs attributed to the play list are then played in the order specified in the play list, i.e., the songs are "reproduced" in the "reproduction order."** Thus, the embodiment recited in Applicant's claim 1 is different from Nonaka in the following respects: (1) In Nonaka, the lists are simply lists of songs which have **similar attributes;** and (2) In Nonaka, the lists designate the order at which songs were **recorded**. The lists of Nonaka do not describe the "reproduction order", i.e., the order in which songs will be played back, recited in claim 1. Accordingly, Nonaka does not disclose "a record medium holding . . . (2) a plurality of play list files of storing a play list describing a reproduction order of the plurality of data files" and "data reproducing means of reproducing the predetermined data stored by the plurality of data files respectively by using the reproduction order based on the selected play list file," as required by Applicants' claim 1. Withdrawal of the rejection and reconsideration of claim 1 are respectfully requested.

Claims 2 and 4 depend from claim 1 and therefore include all of the features of claim 1. Claims 5, 7, 8 and 10-12, while not identical to claim 1, include features similar to claim 1. Claim 6 depends from claim 5; claim 9 depends from claim 8; claim 13 depends from claim 10; claim 14 depends from claim 11; and claim 15 depends from claim 12. Accordingly, claims 2 and 4-15 are also patentable over Nonaka for at least the reasons set forth above. Claims 16-18 were previously cancelled. Withdrawal of the rejections and reconsideration of claims 2 and 4-15 are respectfully requested.

Claim Rejection under 103(a)

Claim 3 stands rejected under 35 U.S.C. §103(a) as being obvious over Nonaka in view of U.S. Patent No. 6,118,450 to Proehl et al. ("Proehl"). It is respectfully asserted that Proehl does not disclose all of the features recited in claim 3, as argued in the Office Action.

In particular, Proehl does not disclose or suggest the following features of claim 3:

> wherein the play list file menu display means is configured to display the play list file menu information by displaying at least one thumbnail image corresponding to at least one respective play list file, **the displayed at least one thumbnail image changing according to a state in which the play list file selecting means selects the predetermined play list file**. (Emphasis added.)

These features are found in the originally filed application, for example, on page 32, lines 6-20. No new matter has been added.

An embodiment of the above-identified application describes a thumbnail image for a play list file. (See Application, page 18, lines 4-8.) In one embodiment, when the thumbnail image corresponding to a play list is selected, the thumbnail image is changed from a state of non-selection to one of selection. (See Application, page 32, lines 6-10.) A first image is displayed when the thumbnail image is not selected, and a second image is displayed when the thumbnail image is selected. (See Application, page 32, lines 11-15.)

The portion of Proehl relied upon in the Office Action describes changing a display screen when a CD is selected. The display screen, illustrated in FIG. 5, displays a multitude of images, each corresponding to a different CD. (See Proehl, col. 8, lines 13-15.) A user double clicks a cursor over an image corresponding to a desired CD. (See Proehl, col. 8, lines 13-15.) The screen then changes from that illustrated in Fig. 5 to that illustrated in Fig. 6, which illustrates various information about the selected CD, including jacket-cover art, title, available tracks, etc. (See Proehl, col. 8, lines 16-34.) Proehl, in the portion relied upon in the Office Action, does not describe that a thumbnail image changes according to a state of selection of a play list. Accordingly, Applicants respectfully assert that Proehl does not disclose or suggest all of the above-quoted features of claim 3. Withdrawal of the rejection and reconsideration of the claim are respectfully requested.

Conclusion

For the foregoing reasons, withdrawal of the rejections and reconsideration and allowance of the claims are respectfully requested.

Respectfully submitted,

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PKZ/so

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